



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/290,798	04/13/99	HELLSTROM	I 30436.33USC1

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EXAMINER

BANSAL, G

ART UNIT

PAPER NUMBER

1642

10

DATE MAILED:

12/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/290798

Applicant(s)

Heldstrom et al

Examiner

G Banal

Group Art Unit

1642

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 6 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. (30 days)

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 45-92 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 45-92 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other Rest of the FAX form

Office Action Summary

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DETAILED ACTION

1. Applicant's amendments filed October 6, 2000 (Paper No:7/B) is acknowledged. Accordingly, claims 4-12 have been canceled without prejudice, and new claims 45-92 have been added.

Claims 4-12 had been examined and a first office action had been issued. In view of the newly added claims and the change in the scope of the claims, the claims are subjected to a restriction requirement upon further review.

Election/Restriction

2. Restriction to one of the following inventions is required under 35U.S.C. 121:
 - I. Claims 45-58, 85 drawn to an antibody, classified in class 530, subclass 385.
 - II. Claims 59-65, 71, 86 drawn to an immunoconjugate, classified in class 435, subclass 391.7.
 - III. Claim 66, drawn to a single chain antibody, classified in class 530, subclass 387.3 .
 - IV. Claims 67-70, 72-75, 89 drawn to a single chain immunoconjugate, classified in class 435, subclass 7.93 .
 - V. Claims 76-80, drawn to a bifunctional antibody, classified in class 530, subclass 391.7 .
 - VI. Claim 81, drawn to a method of selectively killing cells by antibody, classified in class 435, subclass 7.23 .
 - VII. Claim 82, 87-88 drawn to a method of selectively killing cells by an immunoconjugate, classified in class 435, subclass 7.23 .
 - VIII. Claim 83, drawn to a method of treating a subject by an antibody, classified in class 424, subclass 131.1.
 - IX. Claim 84, drawn to a method of treating a subject by an immunoconjugate, classified in class 424, subclass 178.1 .
 - X. Claims 90-92, drawn to a method of imaging, classified in class 435, subclass 7.23 .

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3. The inventions are distinct, each from the other because of the following reasons:

A. Inventions I - V are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MEP. § 806.04, MEP. § 808.01). In the instant case the different inventions of Groups I-V relate to structurally and functionally different product molecules that are independent and distinct and require different searches.

B. Inventions VI-X are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MEP. § 806.04, MEP. § 808.01). In the instant case the different inventions of Groups VI-X are drawn to different methods which have different method steps, reagents and end points.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the search required for the different groups are different, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

6. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction

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Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. Please limit the use of this dedicated Fax number to responses to Written Restrictions.


7. Papers related to this application may be submitted to Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242 or (703) 305-3014.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geetha P. Bansal whose telephone number is (703) 305-3955. The examiner can normally be reached on Mondays to Thursdays from 7:00am to 4:30pm and alternate Fridays from 7:00am to 3:30pm. A message may be left on the examiner's voice mail service.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Anthony Caputa, can be reached on (703) 308-3995.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

December 14, 2000


GEETHA P. BANSAL
PRIMARY EXAMINER